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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,565	10/21/1999	MEGUMI YOSHIDA	35.G2473	5702
5514	7590	01/18/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			TRAN, MYLINH T	
			ART UNIT	PAPER NUMBER
			2179	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/422,565	YOSHIDA, MEGUMI	
	Examiner	Art Unit	
	Mylinh Tran	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,9-25 and 28-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6, 9-25 and 28-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Applicant's Amendment filed 10/10/05 has been entered and carefully considered. Claims 1-6, 13-15, 20-25, 32-34, 41 and 43 have been amended. Claims 7-8 and 26-27 have been canceled. However, limitations of amended claims have not been found to be patentable over prior art of record; therefore, claims 1-6, 9-25 and 28-43 are rejected under the same ground of rejection as set forth in the Office Action mailed 07/21/05.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 9-10, 20, 21, 25, 28-29, 41 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by the Screen Dumps (Microsoft Office).

As to claim 1, 20, 41 and 43, Microsoft Office discloses a first displaying step of displaying an input screen for inputting a character string on a display (figure 2), wherein a cursor is displayed on the input screen at a position at which the character string is to be inserted (figure 2); 2);

a second displaying step of displaying a list including a plurality of registered character strings on the display when a user enters an instruction to display the list (figure 2); selecting, based on a user instruction, a user desired character string from the plurality of the character strings included in the list displayed in said second displaying step (figure 3); automatically inserting the selected user desired character string at the position of the cursor displayed in said first displaying step (figure 4) when the user desired character string is selected in said selecting step (figure 5) wherein the inserted character string is added to image information which is to be sent to a destination (figure 6).

As to claims 2 and 21, Microsoft Office also discloses the selection of the character string being achieved by an instruction which designates a position in a region of the display screen in which the character string to be selected is displayed (figures 3-5).

As to claims 6 and 25, Microsoft Office also shows the plurality of character strings having been registered through an operation performed by the user (figure 2).

As to claims 9-10 and 28-29, Microsoft Office discloses the selected character string being input to a display screen which is displayed to enable entry of a character string designating a destination to which information is to be sent (figures 5-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-5, 11-19, 22-24, 30-40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Office in view of An et al. [US. 5,936,614].

As to claims 3, 4, 22 and 23, Microsoft Office fails to clearly teach a soft keyboard. However, An et al. shows the limitation at column 8, line 60 through column 9, line 12. It would have been obvious to one of ordinary skill in the art,

at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Office registered character strings. Motivation of the combination would have been to store the character string by the soft keyboard to save time for the users.

As to claims 5 and 24, Microsoft Office fails to clearly teach the list including the registered character strings being displayed in place of the soft keyboard display screen. However, An et al. shows the list including the registered character strings being displayed in place of the soft keyboard display screen, in response to said instruction (column 13, lines 11-30). It would have been obvious to one of ordinary skill in the art,

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at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Office registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claims 11 and 30, Microsoft Office fails to clearly teach the display of the registered character strings being displayed on an operation panel of a copying machine. However, An et al. show the feature at column 1, lines 31-53. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Office registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claims 12 and 31, Microsoft Office fails to clearly teach the selected character string being output by means of a printer. However, An et al. show the feature at column 14, line 60 through column 15, line 19. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Office's registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claims 13, 15, 32 and 34, Microsoft Office fails to clearly teach instruction being given through a touch panel and the instruction being

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given through a coordinate input device. However, An et al. show the features at column 16, lines 35-60. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Office registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claims 14 and 33, Microsoft Office fails to clearly teach instruction being given through a digitizer. However, An et al. show the features at column 6, lines 4-35. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Office registered character strings.

Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claim 16, Microsoft Office discloses displaying a list including a plurality of registered character strings on a display screen (figure 2); user selecting, from the displayed list, based on a user instruction, one of the character string included in the list displayed in said step displaying step and storing the selected character string in a computer-readable memory medium (figure 3);

pointing a cursor at a position on the display screen at which the selected character string is to be inserted (figure 4);

automatically inserting the selected character string stored in the memory medium at the position pointed by the cursor (figure 5), wherein the inserted character string is added to image information which is to be sent to a destination (figure 6).

Microsoft Office fails to clearly teach the step of character editing. However, An et al. show the feature at column 3, lines 10-29. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Office registered character strings. Motivation of the combination would have been to help the user having a desired character string.

As to claims 17,18, 36-37 and 39-40, Microsoft Office fails to clearly teach the editorial instruction being to add or delete a character. However, An et al. show the feature at column 2, lines 35-48. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Office registered character strings. Motivation of the combination would have been to help the user having a desired character string.

As to claims 19 and 38, Microsoft Office fails to clearly teach the instruction being input through a displayed soft keyboard. However, An et al. show the features at column 3, lines 10-47. It would have been obvious to one of ordinary skill in the art, at the time the invention was

made, to combine An's teaching of the soft keyboard with Microsoft Office registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claims 35 and 42, Microsoft Office discloses displaying a list including a plurality of registered character strings on a display screen (figure 2); user selecting, from the displayed list, based on a user instruction, one of the character string included in the list displayed in said step displaying step and storing the selected character string in a computer-readable memory medium (figure 3); pointing a cursor at a position on the display screen at which the selected character string is to be inserted (figure 4); automatically inserting the selected character string stored in the memory medium at the position pointed by the cursor (figure 5), wherein the inserted character string is added to image information which is to be sent to a destination (figure 6). Microsoft Office fails to clearly teach the inputting means for enabling input of an editorial instruction indicating an editorial work to be effected on the selected character string. However, An et al. show the feature at column 1, lines 30-60. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Office registered character strings. Motivation of the combination would have been to store

the character strings by the soft keyboard to save time for the users.

Response to Arguments

Applicant has argued that a copyright notice dating from 1995 to 1999 of the functionality of the software of Microsoft Office could have been on or after October 22, 1999. However, the Examiner has found in the Microsoft Office 97 that the Microsoft Outlook is copyrighted on 1997. Therefore, the Microsoft Outlook Screen Dumps is still persuasive prior art.

Applicant also argues the prior arts do not disclose the step of automatically inserting the addressee when a user selects the addressee from a list.

However, in Microsoft Office, in order to insert the user desired character at the position of the cursor, the user needs to "click" OK button in figure 3. The step of clicking OK is similar with the step of selecting OK button in figure 10 of the invention application. How does the user insert a selected character string "BCD Company" from figure 15 into figure 16 (of figure 10)?

Therefore, the step of automatically inserting the desired character string of the Microsoft Outlook Screen Dumps is similar to the step of automatically inserting the desired character string of the application (see page 27 of the specification).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4141.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached at 571-272-4847.

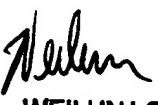
The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Mylinh Tran

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WEILUN LO
SUPERVISORY PATENT EXAMINER